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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,452	08/24/2001	Edmund W. Figiel	1944.NVF	2230

7590 10/07/2003

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EXAMINER

ANTHONY, JOSEPH DAVID

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 10/07/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/938,452	<b>Applicant(s)</b> FIGIEL ET AL.	
	<b>Examiner</b> Joseph D. Anthony	<b>Art Unit</b> 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/12/01 and 12/19/02, both as IDS.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 10-18 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

***DETAILED ACTION***

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-9 and 19-21 are, drawn to a fire retardant composition that may be in gelled form, classified in class 252, subclass 601.
  - II. Claims 10-18, drawn to a fire retardant composition in the form of foam, classified in class 252, subclass 8.05.
  - III. Claim 22, drawn to a method for retarding the spread of a fire, classified in class 169, subclass 47.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions (I and II) and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a cosmetic formulation.
3. Inventions I and II are recognized as distinct from each other since they are drawn to compositions that are in two different physical forms. As can be readily understood, a gelled composition would not be deemed to be the functional equivalent of a foamed composition.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Jane Gennaro on 12/31/02 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-9 and 19-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-18 and 22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Silano et al. U.S. patent Number 4,400,480.

Silano et al teaches aqueous alkaline thickened compositions that comprise dihydroxyethylene urea and starch, see abstract and claims 1 and 4. Applicant's claims are deemed to be anticipated over the examples.

11. Claims 1-9 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson U.S. Patent Number 3,635,835.

Peterson discloses gelled acidic compositions that comprise in part hydroxyalkyl urea, see abstract, examples, claims and column 3, line 13 to column 4, line 14.

Peterson differs from applicant's claimed invention in that there is no direct teaching (i.e. by way of an example) to a gelled composition that does not include a highly flammable fuel component that renders the gel product flammable.

It would have been obvious to one having ordinary skill in the art to use the direct disclosure of the reference as motivation to make a gelled composition that does not contain a highly flammable fuel. This is not only obvious over the

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broad disclosure of the patent, but such non-flammable gelled compositions are directly claimed, see claim 1.

12. Claims 1, 9, and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Itoh et al. U.S. Patent Number 5,437,902 or Chiotis et al. U.S. Patent Number 5,441,560.

Itoh et al teaches fire-resistant glass that has an alkaline aqueous gel layer.

Applicant's claims are deemed to be anticipated over examples 3, 5, and 7.

Chiotis et al teaches flame retardant gel compositions, see abstract. Applicant's claims are deemed to be anticipated over the gelled composition taught in column 8, lines 29-32.

13. Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Winkler, III U.S. Patent Number 5,676,876 or Moore et al. U.S. Patent Number 5,125,952 or Leitner U.S. Patent Number 4,444,831 or Roth U.S. Patent Number 4,110,509 or Rohringer et al. U.S. Patent Number 4,382,884.

All said patent teach aqueous thickened compositions that comprise urea or a urea derivative. Applicant's claims are deemed to be anticipated over the examples of each patent.

14. Claims 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaylor U.S. Patent Number 5,062,996 or Leake et al. U.S. Patent Number 4,424,291 or Wood

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et al. U.S. Patent Number 4,246,146 or Schoenholz et al. U.S. Patent Number 4,384,988 or von Blucher et al. U.S. Patent Number 5,190,110.

All said patents teach aqueous gels that are deemed to read on applicant's claimed gels. Applicant's claims are deemed to be anticipated over the examples of each patent.

15. Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. U.S. patent Number 4,246,146.

Wood et al has been described above and differs from applicant's claimed invention in that there is no direct teaching (i.e. by way of an example) to where the gelled composition actually contains urea or a urea derivative. It would have been obvious to one having ordinary skill in the art to use the disclosure of the patent at, column 9, lines 1-4, as strong motivation to actually add urea or a urea derivative to the taught gelled composition.

***Prior-Art Cited But Not Applied***

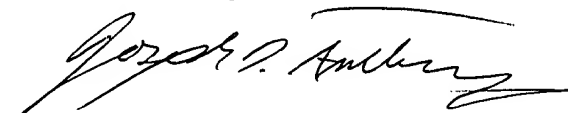
16. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

***Examiner Information***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number

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is (703) 308-0446. This examiner can normally be reached on Monday through Thursday from 7:35 a.m. to 6:00 p.m. in the eastern time zone. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The group FAX machine number is (703) 872-9306. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0651. The receptionist is located on the 8<sup>th</sup> floor of Crystal Plaza 3 (e.g. CP-3) and will be the welcome point for all visitors to the building.



**Joseph D. Anthony**  
**Primary Patent Examiner**  
**Art Unit 1714**

9/22/03